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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,051	03/12/2004	Rick A. Carek	2834/103	8577

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BROMBERG & SUNSTEIN LLP  
125 SUMMER STREET  
BOSTON, MA 02110-1618

EXAMINER
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HOLMES, MICHAEL B

ART UNIT	PAPER NUMBER
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2121

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/800,051	<b>Applicant(s)</b> CAREK ET AL.	
	<b>Examiner</b> Michael B. Holmes	<b>Art Unit</b> 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                            |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12162004/07222005</u> . | 6) <input type="checkbox"/> Other: _____                                                |



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**Examiner's Detailed Office Action**

**Claim Rejections - 35 USC § 101**

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The invention as disclosed in claims 1-22 are rejected under 35 U.S.C. 101 as being non-statutory subject matter.
3. Claims 1-22 appear to be directed to an abstract idea rather than a practical application of an abstract idea which would produce a "useful, concrete or tangible results." Specifically, the claims involves storing and modeling documents for generating computer-aided design models. However, the claims fail to provide a practical application and is insufficient to establish a real world "tangible" result i.e., storing and modeling documents for generating computer-aided design models, in and of itself does not produce any result that is a practical application.
4. In addition to the aforementioned deficiency, claims 1-22 have one additional problem. The claims constitute software modules devoid of any apparent hardware, and therefore are computer programs e.g., functional descriptive material. Moreover, since the computer programs are not embodied on an appropriate computer-readable storage medium. They are not patent eligible

subject matter in accordance with *In re Warmerdam*, 31 USPQ2d, 1354.

5. Devoid of such, applicant's claimed invention is an abstract idea e.g., a computational model or a mathematical manipulation of a function or equation. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness. *see In re Sarkar*, 588 F.2d at 1335, 200 USPQ at 139, wherein the court explained why this approach must be followed:

No mathematical equation can be used, as a practical matter, without establishing and substituting values for the variables expressed therein. Substitution of values dictated by the formula has thus been viewed as a form of mathematical step. If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a "process" under 101. Consideration of whether the substitution of specific values is enough to convert the disembodied ideas present in the formula into an embodiment of those ideas, or into an application of the formula, is foreclosed by the current state of the law.

6. A claim is limited to a practical application when the method or system, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. *See AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452. *See* MPEP § 2106(IV) The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth invention in the specification. The claims must also reflect the scope and breath of applicant's invention. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). The situation in this application

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appears to be more difficult since it does not appear that the practical application is contained within the specification.

### Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Shibao et al.* (USPN 5,355,445) in view of *Bendik* (USPN 7,127,670 B2).

Regarding claim 1. *Shibao et al.* discloses a computer-aided modeling system comprising:

a computer-aided design system; [see *Shibao et al.* C 2, L 62 to C 3, L 7]

a product document management system; and

a knowledge management system [see *Shibao et al.* C 2, L 62 to C 3, L 7] operably coupled to the product document management system for storing and retrieving modeling documents and to the computer-aided design system for generating computer-aided design models based on the modeling documents, the knowledge management system [see *Shibao et al.* C 2, L 62 to C 3, L 7] having integrated support for the product document management system.

*Shibao et al.* does not disclose a product document management system. However, *Bendik* discloses a product document management system. [see C 6, L 66 to C 7, L 67] It would have

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been obvious at the time the invention was made to a persons having ordinary skill in the art to combine *Shibao et al.* with *Bendik* because *Bendik* relates to systems and methods for management of documents and particularly, to systems and methods for management of documents over a network of computers in which a user can gain access to the information repository from a computer having access to the network. [see C 1, L 13-17]

*Shibao et al.* does not disclose a product document management system. However, *Bendik* discloses a product document management system. [see C 6, L 66 to C 7, L 67] It would have been obvious at the time the invention was made to a persons having ordinary skill in the art to combine *Shibao et al.* with *Bendik* because *Bendik* relates to systems and methods for management of documents and particularly, to systems and methods for management of documents over a network of computers in which a user can gain access to the information repository from a computer having access to the network. [see C 1, L 13-17]

9. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Shibao et al.* (USPN 5,355,445) in view of *Bendik* (USPN 7,127,670 B2) further in view of *Gillespie et al.* (USPN 7, 035,839 B1).

*Shibao et al.* in view of *Bendik*, has been discussed above and does not teach the bolded limitations of claims 2-4 i.e., **document access manager, document access manager is implemented as a dynamic link library, and a fileshare accessible by the document access manager.** However, *Gillespie et al.* discloses **document access manager, document access**

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**manager is implemented as a dynamic link library, and a fileshare accessible by the document access manager.**

Regarding claims 2-4. *Gillespie et al.* wherein the knowledge management system comprises a knowledge management application and a **document access manager** [see *Gillespie et al.* C 2, L 18-42 & C 5, L 1-13] in communication with the product document management system, wherein the knowledge management application interfaces with the product document management system through the **document access manager**. [see *Gillespie et al.* C 2, L 18-42 & C 5, L 1-13] Regarding claim 3. wherein the **document access manager is implemented as a dynamic link library**. [see C 2, L 18-42 & C 2, L 59 to C 3, L 50 & C 5, L 1-13] Regarding claim 4. further comprising **a fileshare accessible by the document access manager**, wherein the document access manager selects between the product document management system and the fileshare for managing documents. [see C 2, L 18-42 & C 2, L 59 to C 3, L 50 & C 5, L 1-13]

It would have been obvious at the time the invention was made to a persons having ordinary skill in the art to combine *Shibao et al.*, *Bendik* and *Gillespie et al.* because an object of the present invention to provide a document management extension system for use as an extension to a document collection and management software program, wherein the document management extension system saves the content (or object) and metadata (or index data) in the information store (i.e., database or messaging system, or message store) within, for example, MICROSOFT EXCHANGE, rather than saving the content or metadata in a file system. [see C 2, L 18-26]

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Regarding claim 5. *Bendik* discloses wherein the product document management system includes at least one predefined document management object specific to the knowledge management system for storing knowledge management system documents related to corresponding computer-aided design system documents. [see C 1, L 59 to C 2, L 1]

Regarding claim 6. *Bendik* discloses wherein the product document management system includes a plurality of knowledge management system specific document management objects, each associated with a different type of computer-aided design system document. [see FIG. 7, C 8, L 45-51]

Regarding claim 21. *Shibao et al.* discloses an apparatus for computer-aided design modeling, the apparatus comprising:

means for storing and managing knowledge management documents [see Abstract, *Shibao et al.* C 2, L 62 to C 3, L 7] in a product document management system; and  
means for generating instructions to a computer-aided design system based on the knowledge management documents. [see Abstract, *Shibao et al.* C 2, L 62 to C 3, L 7]

*Shibao et al.* does not disclose a product document management system. However, *Bendik* discloses a product document management system. [see C 6, L 66 to C 7, L 67] It would have been obvious at the time the invention was made to a persons having ordinary skill in the art to combine *Shibao et al.* with *Bendik* because *Bendik* relates to systems and methods for management of documents and particularly, to systems and methods for management of documents over a network of computers in which a user can gain access to the information repository from a



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computer having access to the network. [see C 1, L 13-17]

Regarding claim 22. *Bendik* discloses means for generating part numbers for computer-aided design system parts based on part number documents stored in the product document management system. [see FIG. 7, C 8, L 45-51]

### Correspondence Information

10. Any inquires concerning this communication or earlier communications from the examiner should be directed to Michael B. Holmes, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-3686 or facsimile transmission (571) 273-3686 or email [Michael.holmesb@uspto.gov](mailto:Michael.holmesb@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony Knight, may be reached at (571) 272-3687.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

**Michael B. Holmes**

Patent Examiner

Artificial Intelligence

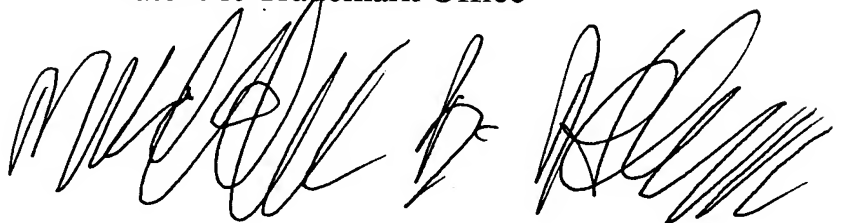
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United States Department of Commerce

Patent & Trademark Office

Thursday, December 7, 2006

MBH

A large, stylized handwritten signature in black ink, likely belonging to Michael B. Holmes, is written over the typed name and title.